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LOWE HAUPTMAN GILMAN & BERNER, LLP  
Suite 310  
1700 Diagonal Road  
Alexandria, VA 22314

EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 07/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/829,392

Applicant(s)

I'ANSON ET AL.

Examiner

Nicholas D. Rosen

Art Unit

3625

*MW*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 21-28 is/are rejected.
- 7) ☒ Claim(s) 14-20 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

Claims 1-28 have been examined.

#### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-3, 12, 13, 21, and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. There is no practical application within the technological arts. Capturing and presenting data about merchandise or other "items of interest" may be useful, but is not, in itself, concrete or tangible. Furthermore, claim 1 does not recite any steps limited to using or manipulating technology. It does not specify use of a computer, for example, and the steps of capturing, organizing, and presenting data might be carried out using a pencil and paper, or even as a mental process, with the data being presented by speaking to someone about what items of interest are available at which shop. (Moreover, according to the Patent Office's current interpretation, a merely nominal recitation of technology may be insufficient to overcome a rejection under 35 U.S.C. 101.)

A claim is limited to a practical application when the method, as claimed, produces a concrete tangible, and useful result: i.e., the method recites a step or act of producing something that is concrete, tangible, and useful. See *AT&T v. Excel Communications Inc.*, 172 F.3d at 1358, 50 USPQ2d at 1452.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-13, 21, and 22**

Claims 1, 12, 13, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stapp (U.S. Patent 5,930,771). As per claim 1, Stapp discloses a shopping assistance method, comprising the step of: (a) capturing, in respect of two or more shops, item data about items of interest at these shops, at least the item data being captured at premises of the shops concerned (Abstract). Stapp does not expressly disclose capturing store data indicative of the identity of the shops (although in his system, the time slot during which records are transmitted could serve as store identification), but his "detailed analysis of the preferences and buying patterns of the patrons of each individual machine" (column 4, lines 28-32) would be impossible if store data indicative of the identity of the shops were not also captured. Stapp further implies (b) organizing the captured data so as to associate each piece of item data captured with the store data for the shop where the item data was captured, and discloses (c) presenting the captured data to show for each shop, information about the items of interest for which item data was captured in that shop (column 7, lines 12-19).

As per claim 12, Stapp discloses presenting information on what types of goods have sold well (column 7, lines 12-22), which inherently implies determining at least the types of said items of interest.

As per claim 13, Stapp does not expressly disclose that processing of the captured data involves one or more of the listed operations, but does disclose the use of bar code data (Abstract; column 4, lines 11-18 and 52-66; etc.). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for processing of the captured data to involve interpreting bar code image data in said information, for the obvious advantage of being able to interpret data of a type known to be gathered in implementation of Stapp's system.

As per claim 21, Stapp discloses that at least one item of interest is a product on offer for sale or hire (column 4, line 52, through column 5, line 24).

Claims 2, 3, 6, 7, 8, 9, 10, 11, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stapp as applied to claim 1 above, and further in view of official notice. As per claim 2, Stapp does not expressly disclose that the store data comprises location data, but official notice is taken that it is well known for store data to comprise location data. (Stapp hints at this by disclosing a route service person (column 7, lines 17-19); also the "predetermined groups" (Abstract) could be geographical groups.) Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the store data to comprise location data, for the obvious advantage of assisting interested persons in finding the stores, or for analyzing sales results according to location.

Art Unit: 3625

As per claim 3, Stapp does not expressly disclose that the store data comprises a business identifier, this business identifier being used to look up the location of the shop concerned, but official notice is taken that it is well known for store data to comprise a business identifier, the business identifier being used to look up the location of the shop concerned (e.g., store name data can be used to look up the location of the shop concerned in a telephone directory, paper or on-line). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the store data to comprise a business identifier, this business identifier being used to look up the location of the shop concerned, for the obvious advantage of assisting interested persons in going to the store, or in such other tasks as analyzing sales by geography.

As per claim 6, Stapp does not disclose that the item data comprises image data, the information presented comprising at least a thumbnail of the image data captured for each item, but official notice is taken that it is well known for item data to comprise image data, and thumbnail image data in particular. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the item data to comprise image data, and the information presented to comprise at least a thumbnail of the image data captured, for the obvious advantage of conveniently presenting visual information to interested persons.

As per claim 7, Stapp discloses that the captured data item is passed to a service system where it is processed to identify the type of each item of interest (e.g., column 4, lines 28-32), the item type information being made available for remote access to effect

said presentation (column 7, lines 12-22), but does not expressly disclose that further data is obtained about each item, and also made available for said presentation.

However, official notice is taken that it is well known to use information to look up further information (e.g., by entering a search item in a search engine, or seeing how much of an item sold at a vending machine is available at a warehouse from which vending machines are stocked, etc.). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to obtain further data about each item, and make the further data available, for the obvious advantage of using further data (which could be of any of a number of types) to take appropriate action regarding the item, e.g., to minimize inventory outage and product spoilage, and thereby maximize profitability.

As per claim 8, Stapp discloses that said store data is provided to or obtained by said service system (at least by implication; see rejection of claim 1 above) (Abstract; column 4, lines 28-32; etc.) and made available for remote access in said presentation (column 7, lines 12-19).

As per claim 9, Stapp does not disclose that said further data comprises hyperlink data to relevant specific information sources, but official notice is taken that hyperlink data to relevant specific information sources is well known. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for said further data comprises hyperlink data to relevant specific information sources, for the obvious advantage of making further data conveniently available to users of the World Wide Web or other hypertext networks.

As per claim 10, Stapp does not expressly disclose accessing further information in response to activation of a hyperlink presented in step (c) using said hyperlink data, but official notice is taken that it is well known to access information in response to activation of a hyperlink. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to access further information in response to activation of a hyperlink presented in step (c) using said hyperlink data, for the obvious advantage of making information conveniently available to users of the World Wide Web or other hypertext networks.

As per claim 11, Stapp does not expressly disclose that processing of the captured data involves one or more of the listed operations, but does disclose the use of bar code data (Abstract; column 4, lines 11-18 and 52-66; etc.). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for processing of the captured data to involve interpreting bar code image data in said information, for the obvious advantage of being able to interpret data of a type known to be gathered in implementation of Stapp's system.

As per claim 22, Stapp does not disclose that at least one item of interest is a service, but official notice is taken that it is well known for shops, and in particular, for vending machines, to offer services. Examples include weighing machines, and machines that measure a customer's blood pressure. Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for at least one item of interest to be a service, for the obvious advantage of profiting from the sale of services.



Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stapp as applied to claim 1 above, and further in view of Ayed (U.S. Patent 6,756,913). Stapp does not disclose that the location of a said shop is captured by obtaining the location of a cellular radio device positioned at the shop from a location server of a cellular radio infrastructure. However, Stapp discloses the use of cellular phones at stores (Abstract; Figures 1 and 3; etc.), and Ayed teaches that it is well known to use messages from cellular radio devices to determine locations, with the aid of server (Abstract; column 2, lines 6-23). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the location of a said shop to be captured by obtaining the location of a cellular radio device positioned at the shop from a location server of a cellular radio infrastructure, for the obvious advantage of knowing where to go to buy from, restock, or otherwise deal with the shop.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stapp and official notice as applied to claim 2 above, and further in view of Gershman et al. (U.S. Patent 6,199,099). Stapp does not disclose presenting information through an initial image in the form of a map display showing the relative locations of the shops visited, information about the items of interest associated with each shop being selectively displayed from this image. However, Gershman teaches presenting information through an initial image in the form of a map display showing the relative locations of the shops visited, information about the items of interest associated with each shop being selectively displayed from this image (column 2, line 56, through column 3, line 2; column 53, lines 1-28; Figure 27A). Hence, it would have been

obvious to one of ordinary skill in the art of commerce at the time of applicant's invention to present information through an initial image in the form of a map display showing the relative locations of the shops visited, information about the items of interest associated with each shop being selectively displayed from this image, for the advantage, as taught by Gershman, of assisting shoppers in finding desired items, and at the lowest price.

#### **Claims 23-28**

Claims 23, 24, 25, 26, and 27 are essentially parallel to claims 1, 7, 2, 6, and 5, respectively, and rejected under 35 U.S.C. 103(a) on essentially the same grounds, as unpatentable over Stapp, official notice, and, in the case claim 27, Gershman, for the reasons set forth above.

Claim 28 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Stapp, official notice, and Gershman. Stapp does not expressly disclose that the store data comprises location data, but official notice is taken that it is well known for store data to comprise location data. (Stapp hints at this by disclosing a route service person (column 7, lines 17-19); also the "predetermined groups" (Abstract) could be geographical groups.) Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the store data to comprise location data, for the obvious advantage of assisting interested persons in finding the stores, or for analyzing sales results according to location.

Stapp does not disclose that the presentation means uses the location data associated with a said shop to appropriately place a representation of the shop on the

Art Unit: 3625

map display, but Gershman teaches using location data associated with a said shop to appropriately place a representation of the shop on a map display (Figure 27A; column 53, lines 1-28). Hence, it would have been obvious to one of ordinary skill in the art of commerce at the time of applicant's invention for the presentation means to use the location data associated with a said shop to appropriately place a representation of the shop on the map display, for the obvious advantage of having the map display accurately reflect the shop locations.

### ***Allowable Subject Matter***

Claims 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Stapp (U.S. Patent 5,930,771), discloses or makes obvious the elements of claim 1. However, Stapp does not disclose that said item data and store data are both captured by a shopper at the or each shop and are subsequently downloaded to the shopper's local computer where step (c) is carried out, nor does Stapp have step (c), presenting the captured data to show for each shop, information about the items of interest for which said item data was captured in that shop, carried out at a shopper's local computer, or involve a shopper's local computer at all. It is known to transfer data from a digital camera, cell phone, or other mobile device to a personal computer, as taught, for example, by the article, "Ricoh Uses RDC-1

Camera to Demonstrate Why the Future of Photography Is Digital,” but that is not sufficient to make it obvious for a shopper to capture item data in accordance with claim 1 using a mobile device, and then download it to the shopper’s local computer. It is known for shoppers to, for example, take notes on items they have observed for sale at two or more stores, and it would be surprising if no one had ever entered his notes into a personal computer, but manual entry of data is not the same as downloading. Stapp does not disclose the further step of passing at least some of the captured item data to a remote service system to obtain further data about an item of interest, but passing data to a remote service system to obtain further data (e.g., entering a search term in a search engine) is well known. Without anything in claim 14 being an absolute technological novelty, the combination of prior art that would be needed to reconstruct the claimed limitations, and the lack of statements of motivation for such a reconstruction in the nearest prior art of record, is held to make the subject matter of claim 14 allowable.

Claims 18-20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The closest prior art of record, Stapp (U.S. Patent 5,930,771), discloses or makes obvious the elements of claim 1. However, Stapp does not disclose that said item data is captured by a shopper at the or each shop and subsequently downloaded to the shopper’s local computer where store data is input by the shopper to complete

Art Unit: 3625

steps (b) and (c) is carried out, nor does Stapp have step (c), presenting the captured data to show for each shop, information about the items of interest for which said item data was captured in that shop, carried out at a shopper's local computer, or involve a shopper's local computer at all. It is known to transfer data from a digital camera, cell phone, or other mobile device to a personal computer, as taught, for example, by the article, "Ricoh Uses RDC-1 Camera to Demonstrate Why the Future of Photography Is Digital," but that is not sufficient to make it obvious for a shopper to capture item data in accordance with claim 1 using a mobile device, and then download it to the shopper's local computer. It is known for shoppers to, for example, take notes on items they have observed for sale at two or more stores, and it would be surprising if no one had ever entered his notes into a personal computer, but manual entry of data is not the same as downloading. Stapp does not disclose the further step of using the store data to contact websites of the relevant shops to retrieve further data about at least selected ones of said items, but using store data (e.g., URL's of stores' websites) to contact stores and obtain information is well known. Without anything in claim 14 being an absolute technological novelty, the combination of prior art that would be needed to reconstruct the claimed limitations, and the lack of statements of motivation for such a reconstruction in the nearest prior art of record, is held to make the subject matter of claim 14 allowable.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ogasawara (U.S. Patent 6,123,259) discloses an electronic shopping system including customer relocation recognition. Sattar et al. (U.S. Patent 6,154,728) disclose an apparatus, method, and system for distributed and automatic inventory, status, and database creation and control for remote communication sites. O'Neill et al. (U.S. Patent 6,219,653) disclose a freight calculation system and method of operation. Hirono (U.S. Patent 6,263,343) discloses a system for providing and linking regularly updated map data with related data. Rothschild (U.S. Patent 6,430,54) discloses an interactive system for investigating products on a network. Nambudiri et al. (U.S. Patent 6,640,214) disclose a portable electronic terminal and data processing system.

Hill et al. (U.S. Patent Application Publication 2002/0078363) disclose an apparatus and method for gathering and utilizing data. Edgar et al. (U.S. Patent Application Publication 2002/0091590) disclose a fundraising system with creation, coordination, and order tracking tools. Busche et al. (U.S. Patent Application Publication 2003/0055707) disclose a method and system for integrating spatial analysis and data mining analysis to ascertain favorable positioning of products in a retail environment. Ogasawara (U.S. Patent Application Publication 2003/0065728) discloses an electronic shopping system utilizing a program downloadable wireless videophone. Covington et al. (U.S. Patent Application Publication 2003/0154135)

disclose an interactive in-store/in-mall and on-line shopping system and method (the status of this published application as prior art may be open to question).

Poland et al. (EP 0 608 252) disclose an apparatus for communicating price changes, including printer and display devices.

Spethman, "Test Market USA," discloses gathering information about products in stores. The anonymous article, "All the Technology for Tomorrow's Shopper Is Here Today: We have It, Says ICL," discloses computer-assisted shopping systems. The anonymous article, "Ricoh Uses RDC-1 Camera to Demonstrate Why the Future of Photography Is Digital," discloses transferring images to a personal computer. The anonymous article, "Scan It Yourself," discloses shopping technologies.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 703-305-0753. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on 703-308-1344. (Wynn Coggins is currently on assignment elsewhere in the Patent Office; the examiner's acting supervisor, Jeffrey Smith, can be reached at 703-308-3588.) The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Non-official/draft communications can be faxed to the examiner at 703-746-5574.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Application/Control Number: 09/829,392

Page 15

Art Unit: 3625

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

*Nicholas D. Rosen*

**NICHOLAS D. ROSEN**  
**PRIMARY EXAMINER**

July 17, 2004